

REMARKS

This responds to the Office Action mailed on May 23, 2005.

No claims are amended, canceled, or added. As a result, claims 5-30 remain pending in this application.

Interview Summary

Applicant thanks Examiner Cam Y. T. Truong for the courtesy of a telephone interview on May 16, 2005 with Applicant's representative Walter W. Nielsen. The Examiner agreed to withdraw the previous, erroneous Final Office Action mailed April 7, 2005.

Rejection of Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 under 35 U.S.C. §103(a) as Unpatentable over Funaki in view of Fung

Claims 5-8, 10, 11, 13-15, 17, 20-22, 24, and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki (U.S. 6,689,946) in view of Fung (U.S. 6,687,689).

Funaki discloses a computer-based song-writing system for retrieving candidate words to match corresponding music (see col. 12, lines 7-28). The candidate words may be selected in part based upon the number of syllables they contain, and in part based upon the words' part of speech. It is noted that in Funaki the search engine does not retrieve from the database a unique hit, but rather the search engine may retrieve several candidate words (see col. 8, lines 44-45). Further, it will be noted that in Funaki the search engine retrieves individual words rather than a document.

Fung discloses a document retrieval system, responsive to a natural-language query, to identify documents that are relevant to the user query (see Abstract). It is noted that Fung refers to "documents" (plural) everywhere within its description, abstract, claims, and drawings. Applicant could find no mention of a unique "document" in Fung.

Regarding Applicant's independent claims 5 and 27, the Examiner asserts that Funaki "receives user's input that includes an ordered sequence of number of syllables". However, an "ordered sequence of syllables counts" is definitely not shown by Funaki. Funaki receives only a

number of syllables – not an “ordered sequence of syllable counts”, as recited in each of Applicant’s independent claims. Applicant’s FIG. 5 depicts an example of a “syllable sequence” 404, such as the numerical sequence 1, 1, 3, 1, 1, 2, 1, 1, 2. In each of Applicant’s independent claims 5, 13, 20, and 27, an “ordered sequence of syllable counts” is compared with the contents of a database of analyzed documents. This is not shown anywhere in Funaki.

Moreover, Applicant’s independent claims 5, 13, 20, and 27 further recite “retrieving from the database a document uniquely represented by the search string” [emphasis added]. The Examiner concedes that “Funaki does not explicitly teach the claimed limitation ‘retrieving from the database a document uniquely represented by the search string’”.

However, the Examiner asserts that it would have been obvious to a person of ordinary skill in the art to apply Fung’s teaching of a WIDF (word input document finder) to performing “the remainder of the document finder processing by identifying documents [emphasis added] that are most relevant to the word-sequence user query”. As the Examiner states, Fung identifies documents [emphasis added] that are most relevant to the word-sequence user query. Fung totally fails to identify a document [emphasis added] uniquely represented by the search string.

Moreover, Applicant respectfully traverses the Examiner’s argument that it would have been obvious to combine the teachings of Funaki and Fung. First, motivation is lacking in the Funaki system to retrieve a unique word or document. The objective of the Funaki system is not necessarily to improve time efficiency, but rather it is producing an artistic work having an aesthetic effect. This inherently requires the retrieval of candidate words and the user’s careful and artistic evaluation and selection of the optimum word (see col. 2, lines 29-30; col. 12, lines 21-25).

Second, Funaki doesn’t retrieve documents for a user, as stated by the Examiner. Rather, Funaki retrieves individual words. Each of Applicant’s independent claims 5, 13, 20, and 27 recites that the database contains analyzed documents, and that each document comprises a plurality of words. It will be noted that in Funaki, the database comprises a plurality of words, not a plurality of documents. When a match occurs in Funaki, a word having the indicated number of syllables and the desired part of speech is returned. If more than one word is found, multiple words may be returned. However, in Funaki the database only contains individual

words, not documents each comprising a plurality of words. Thus, Funaki's system is patentably distinguishable from that of Applicant's independent claims 5, 13, 20, and 27.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every limitation of the claim. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

The asserted combination of Funaki in view of Fung fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

For the above reasons, claims 5, 13, 20, and 27 should be found to be allowable over any combination of Funaki and Fung, and Applicant respectfully requests that the rejection of claims 5, 13, 20, and 27 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung should be withdrawn.

In addition, claims 6-8, 10-11, 14-15, 17, 21-22, 24 and 28-29, which depend from claims 5, 13, 20, and 27, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above. Applicant respectfully requests that the rejection of claims 6-8, 10-11, 14-15, 17, 21-22, 24, and 28-29 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung should be withdrawn.

Rejection of Claims 9, 16, and 23
under 35 U.S.C. §103(a) as Unpatentable
over Funaki in view of Fung and Further in view of Erickson

Claims 9, 16, and 23 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung and further in view of Erickson (U.S. 5,765,152).

Erickson discloses a system to provide access to copyrighted media. However, there is no mention of "syllable" in Erickson. Nor is there any mention of an "ordered sequence of syllable counts". Thus, the Examiner's suggested combination of Erickson with Funaki and Fung still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. MPEP §2143.03. Independent claims 5, 13, and 20 are

asserted to be patentable over Funaki in view of Fung for the reasons presented by Applicant above. Thus, claims 9, 16 and 23, which indirectly depend from claims 5, 13, and 20, respectively, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 9, 16 and 23 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung and further in view of Erickson should be withdrawn.

Rejection of Claims 12, 18, 19, 25, 26, and 30
under 35 U.S.C. §103(a) as Unpatentable
over Funaki in view of Fung and Further in view of Wu

Claims 12, 18, 19, 25, 26, and 30 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung and further in view of Wu (U.S. 5,991,756).

Wu discloses a search engine to retrieve documents matching a query term that may comprise a plurality of sub-terms. However, there is no mention of “syllable” in Wu. Wu also fails to disclose any “ordered sequence of syllable counts”. Thus, the Examiner’s suggested combination of Wu with Funaki and Fung still fails to teach or suggest all of the claim limitations present in independent claims 5, 13, 20, and 27, so a *prima facie* case of obviousness has not been established.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *MPEP §2143.03*. Independent claims 5, 13, 20, and 27 are asserted to be patentable over Funaki in view of Fung for the reasons presented by Applicant above. Thus, claims 12, 18, 19, 25, 26, and 30, which indirectly depend from independent claims 5, 13, 20, and 27, and incorporate all of the limitations therein, are also asserted to be allowable for the reasons presented above, and Applicant respectfully requests that the rejection of claims 12, 18, 19, 25, 26, and 30 under 35 U.S.C. §103(a) as being unpatentable over Funaki in view of Fung and further in view of Wu should be withdrawn.

Additional Elements and Limitations

Applicant considers additional elements and limitations of claims 5-30 to further distinguish over the cited references, and Applicant reserves the right to present arguments to this effect at a later date.

Conclusion

Applicant respectfully submits that claims 5-30 are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney, Walter W. Nielsen (located in Phoenix, Arizona) at (602) 298-8920, or the below-signed attorney (located in Minneapolis, Minnesota) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date Aug. 23, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23rd day of August, 2005.

John D. Gustavus Wrathall

Name

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Signature